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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,589	11/10/2003	William B. Rose	1201.68.221	6235
24978 7590 04/15/2009 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
NGUYEN, CHI Q				
ART UNIT		PAPER NUMBER		
3635				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/705,589

Applicant(s)

ROSE, WILLIAM B.

Examiner

CHI Q. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15, 26-29, 31-34, 54, 65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15, 26-29, 31-34, 54 and 65 is/are rejected.
- 7) ☒ Claim(s) 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to applicant's amendment filed on 2/7/2009.

Status of Claims

Claims 1-4, 6-15, 26-29, 31-34, 54 and 65-66 are pending.

Claims 5, 16-25, 30, 35-53, 55-64 and 67-68 have been cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 65 stands rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6,681,530 to Givens.

Givens discloses in Fig. 8, a one-piece flashing for directing water away from a building foundation comprising: a generally vertical section having a first predetermined width; first 116 and second 117 portions of said generally vertical section disposed at an angle with respect to one another; an angled section extending downwardly from said generally vertical section at an obtuse angle therewith and having a second predetermined width, wherein said angled section includes first 119 and second 121 portions disposed at an obtuse angle with respect to one another; and wherein said generally vertical section and said angled section are unitary and constructed from a single sheet of composite material (see cols. 9-10, lines 66-14, respectively and cols. 6- 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-15, 26-29, 31-34 and 54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,681,530 to Givens.

Claims 1 and 54:

Givens discloses in Fig. 8, a one-piece flashing for directing water away from a building foundation comprising: a generally vertical section having a first predetermined width; first 116 and second 117 portions of said generally vertical section disposed at an angle with respect to one another; an angled section extending downwardly from said generally vertical section at an obtuse angle therewith and having a second predetermined width, wherein said angled section includes first 119 and second 121 portions disposed at an obtuse angle with respect to one another; and wherein said generally vertical section and said angled section are unitary and constructed from a single sheet of composite material (see cols. 9-10, lines 66-14, respectively and cols. 6- 7). Givens discloses the basic structures for the flashing as stated above but does not disclose expressly the second predetermined width is substantially larger than the first predetermined width. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention

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was made to have such a different width for desirable application, e.g. encompassing a larger area. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 26-27:

Givens discloses the basic structures for the unibody diverter stated above and further comprising the generally vertical section of said unibody diverter is generally L- shaped but does not disclose expressly a system comprising a first, a second, a third flashings. It would have been an obvious matter to one having ordinary skill in the art at the time the invention was made to have more than one flashing for the system, since it has been held the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 2:

Wherein said first and second portions are disposed at a generally right angle with respect to one another (Fig. 8).

Claims 3-4, 6-7, 9, 28-29, and 31-32:

Givens discloses the basic structures for the flashing as stated above but does not disclose that the vertical section has a width of approximately 10 inches, angled section has width of approximately 30 inches, the first and second portions of said vertical section have a predetermined length of approximately 24, 27, or 44 inches, wherein said angled portion extends downwardly from said vertical portion at a grade of approximately 20%, and wherein said vertical section has a predetermined thickness of approximately 0.045 inches. However,

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these features would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have a specific dimension for its desirable application. Furthermore, applicant has not disclosed the criticality of these features.

Claims 10 and 11:

Givens discloses the basic structures for a unibody diverter as stated above and further comprising the unibody diverter is made out of plastic (see col. 6, line 63) but does not disclose expressly wherein said angled portion comprises rubber. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such the angled portion comprises rubber for easily fit and cover air gap. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 12-13 and 33-34:

Wherein said vertical section includes an attachment system and wherein said attachment system includes at least one fastener 30-32 (see col. 6, line 18).

Claims 14-15:

Givens discloses the basic structures for one-piece flashing as stated above and further disclose a fastener system including nail and hole (30-32- see col. 6 line 18) but does not disclose expressly wherein said fastener comprises at least one bolt or at least one threaded fastener. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a threaded fastener e.g. bolt for a better

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securement because the threaded bolt fastener does not back-out. Furthermore, applicant has not disclosed the criticality of this feature.

Allowable Subject Matter

Claim 66 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

In regarding applicant argues that the prior art fails to disclose a diverter body shaped to surround a generally cylindrical post has been considered but are not persuasive because the argued limitations are not positively claimed and it has been considered as an intended use limitations and therefore it has been that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation. *Ex Parte Masham, 2 USPQ F.2d 1647 (1987)*.

In regarding applicant argues the prior art, Givens fails to disclose or suggest that a width of an angled section of a diverter is substantially larger than a width of a vertical section of the diverter has been considered but are not persuasive because as stated in the Office action this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a different widths in order fit to a different sizes of a building posts or for desirable applications. Furthermore, applicant has not disclosed the criticality of this feature.

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In regarding to applicant argues the prior art Mayle fails to disclose or suggest a through- cut disposed on both the vertical portion and the angled portion has been considered and are persuasive thus the claim is allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

/C. Q. N./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./

Supervisory Patent Examiner, Art Unit 3635